UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,980	08/21/2001	Reinhold Dieing	49774	8232

7590 01/12/2005

Keil & Weinkauf
1350 Connecticut Avenue NW
Washington, DC 20036

EXAMINER	
JIANG, SHAOJIA ANNA	
ART UNIT	**PAPER NUMBER**
1617	

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/913,980	DIEING ET AL.	
	Examiner	Art Unit	
	Shaojia A. Jiang	1617	

-- The MAILING DATE of this communication appears on the cover she t with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) *26-31* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25 and 32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This Office Action is a response to Applicant's amendment and response filed on September 27, 2004 wherein claim 15 is amended; claim 32 is newly submitted.

Currently, claims 1-32 are pending in this application.

It is noted that Claims 26-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim, of record in the previous Office Action dated July 27, 2004.

Claims 1-25 and 32 are currently under examination on the merits.

The terminal disclaimer filed on September 27, 2004, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. 6,403,074 has been reviewed and is accepted. The terminal disclaimer has been recorded. Therefore, the obviousness-type double patenting rejections of Claims 21-25 as being unpatentable over claims 4-7 of U.S. Patent No. 6,403,074, of record stated in the Office Action dated July 27, 2004 is withdrawn.

The terminal disclaimer filed on September 27, 2004, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. 6,770,293 has been reviewed and is accepted. The terminal disclaimer has been recorded. Therefore, the obviousness-type double patenting rejections of Claims 21-25 as being unpatentable over claims 1-25 of U.S. Patent No. 6,770,293, of record stated in the Office Action dated July 27, 2004 is withdrawn.

Applicant's amendment filed September 27, 2004 with respect to the objection of claim 15 made under 37 CFR 1.75 (c) for improper dependent for failing to further limit claim of record stated in the Office Action dated July 27, 2004 has been fully considered and found persuasive since the claim has been amended for proper dependent from claim 1. Therefore, this objection is withdrawn.

Applicant's remarks filed September 27, 2004 with respect to the rejection of claims 1, 5, 12-14, and 16-25 made under 35 U.S.C. 112 first paragraph for lack of scope of enablement of record stated in the Office Action dated July 27, 2004 has been fully considered and is found persuasive to remove since the instant specification is seen to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation as disclosed at page 2, 9-10, and 20 as Applicants assert at page 4 of the Remarks. Therefore, the said rejection is withdrawn.

Applicant's remarks filed September 27, 2004 with respect to the rejection of claims 1-25 made under 35 U.S.C. 112 second paragraph, for recitation "partial hydrolysis" of record stated in the Office Action dated July 27, 2004 has been fully considered and is found persuasive to remove since the instant specification is seen to describe the recitation "partial hydrolysis" at page 20-21. Therefore, the said rejection is withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-25 and 32 are rejected under 35 U.S.C. 102(a) as being anticipated by Blankenburg et al. (WO 99/04750, equivalent to US 6,403,074, PTO-892).

Blankenburg et al. (see US 6,403,074) discloses that the particular polymers which read on or to the instant polymers such as the formula disclosed at X-$C(O)CR^7=CHR^6$ at col.2 lines 41-66, reads on the vinyl ester of C1-C24-carboxylic acids (a) herein; those polymers prepared from the monomers having formula (I) at col.7 line 15 to col.8 line 5, reads on the recitation (b) in claim 2 and in particular same as the recitation (b) claim 6, are useful in the particular cosmetic compositions and/or formulations with specific amounts of ingredients within the instant claims, in the use for hair care such as hairsprays, setting foams, hair mouse, and hair gel (see 6,403,074 the particular examples at col. 8-14 and claims 1-7, especially claims 6-7). Blankenburg also discloses the same product from hydrolysis of the ester functions of original momoners, for example, a compound when X is –OH of formula X-$C(O)CR^7=CHR^6$, is the product from hydrolysis of the ester functions of original momoners.

Response to Argument

Applicant's arguments filed September 27, 2004 with respect to this rejection made under 35 U.S.C. 102(a) as being anticipated by Blankenburg et al. (WO 99/04750) in the previous Office July 27, 2004 have been fully considered but they are

not deemed persuasive to render the claimed invention patentable over the prior art as further discussed below.

Applicants assert that Blankenburg's formula reads on acrylic acids and derivatives (i.e. the double bond is in the acid part of the ester) whereas applicants claim vinyl ester of C1-C24-carboxylic acids (i.e. the double bond is in the alcohol part of the ester). Contrary to Applicants' assertion, the double bond is **not** in the acid part of the ester but between two carbons, X-C(O)$\mathbf{CR^7=CHR^6}$ (see col.2 lines 41-66), which is . Moreover, Blankenburg discloses the same polymers prepared from the monomers and copolymers having same formula (see col.3-4 and 7-8), as instantly claimed and disclosed in the specification herein (page 9, 10-11, 14, 21, 29-30).

Applicants further assert that the produced polymers are distinct, and after having performed the (partial) hydrolysis according to applicants' claims, applicants' polymers have vinyl alcohol units in the polymer backbone, whereas Blankenburg would have carboxylic acid units. Contrary to Applicants' assertion, the instant claims are merely limited to " at least hydrolysis of the ester functions of original momoners". Blankenburg discloses the same product from hydrolysis of the ester functions of original momoners, for example, a compound when X is –OH of formula X-$C(O)CR^7=CHR^6$.

For the above stated reasons, said claims are properly rejected under 35 U.S.C. 102(a). Therefore, said rejection is adhered to.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,579,953 of record in the previous Office July 27, 2004.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is drawn to a pharmaceutical presentation which is interpreted as a composition or formulation, comprising the same ingredients as the instant claims.

Thus, the instant claims 21-25 are seen to be anticipated by the claims 1-6 of U.S. Patent No. 6,579,953.

Note that no terminal disclaimer has been filed to overcome this double patenting rejection.

In view of the rejections to the pending claims set forth above, no claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (571)272-0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Anna Jiang, Ph.D.
Primary Examiner, AU 1617
January 3, 2005